



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,290	12/03/2003	Thomas Anthony Meyers	51373-0009	1289
24115	7590	05/02/2006	EXAMINER	
BUCKINGHAM, DOOLITTLE & BURROUGHS, LLP			BATSON, VICTOR D	
50 S. MAIN STREET			ART UNIT	
AKRON, OH 44308			PAPER NUMBER	
			3671	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/707,290

**Applicant(s)**

MEYERS ET AL.

**Examiner**

Victor Batson

**Art Unit**

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 16-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Robinson et al. (6,708,431).

Robinson et al. discloses an excavator tooth system comprising a mounting nose (12) having a projecting spigot and a wear member (14) having at one end a socket (34). The wear member has spaced sidewalls, upper walls, and lower walls, converging from a rearwardly facing socket opening. The wear member has a forward bearing face, a rear bearing face, and an intermediate face (see figure below). The forward and rear bearing faces are parallel to the longitudinal axis of the wear member. The front and rear bearing faces are engageable with complementary bearing faces on the spigot.

Regarding claims 2-7, 11-12: The forward end of the socket forms an end bearing face. The end bearing face extends transversely to the longitudinal axis. The wear member (13) is an adapter. The wear member includes aligned apertures (36) in opposite sidewalls of the socket. The socket opening has a transverse width greater than the forward end of the socket, and the sidewalls of the socket taper convergently towards the forward end (see fig. 2 copied below).

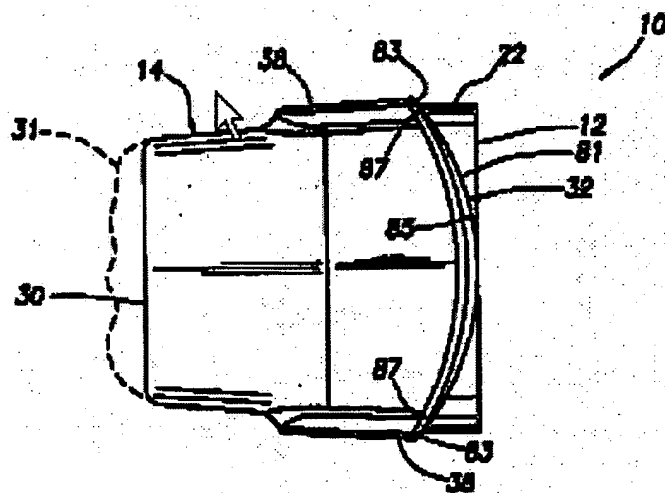
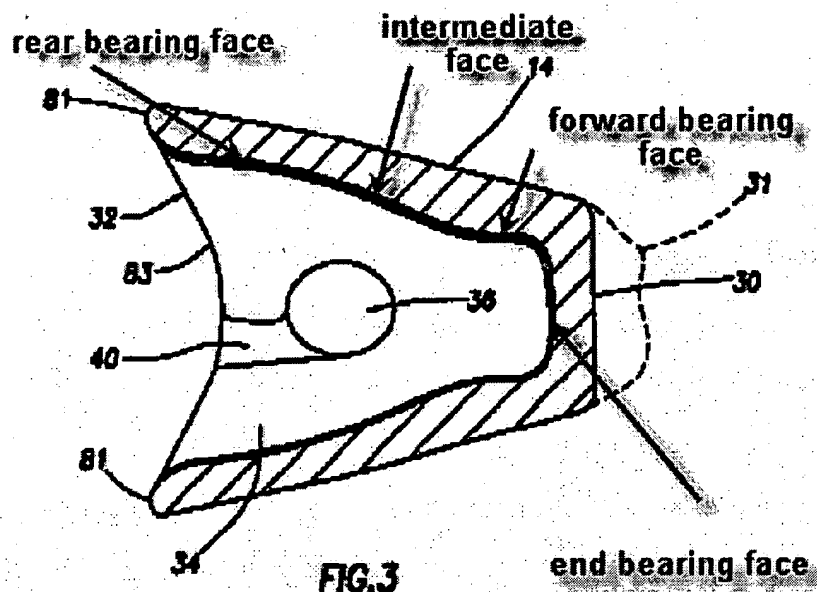


FIG. 2

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (6,708,431).

Regarding claims 8-10: Robinson et al. discloses the claimed invention, as stated previously, except for disclosing the relative dimensions of the rear bearing face to the forward bearing face. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the rear bearing face with a width or area greater than, or the same as, the forward bearing face, since it has been held that where the general conditions of a claim are disclosed, discovering the optimum or workable ranges involves only routine skill. See MPEP 2144.05.

Regarding claims 13-15: While the Robinson '431 patent only shows the details of the subcombination i.e., the excavator tooth system, the tooth system disclosed by Robinson et al., is inherently a part of an excavation device, and the mounting nose would be attached to the excavation device (e.g., the lip of a bucket).

***Response to Arguments***

Applicant's arguments filed 2/15/06 have been fully considered but they are not persuasive. Applicant argues that Robinson et al. does not meet the limitation of the front and rear bearing faces being substantially parallel to a longitudinal axis of said

Art Unit: 3671

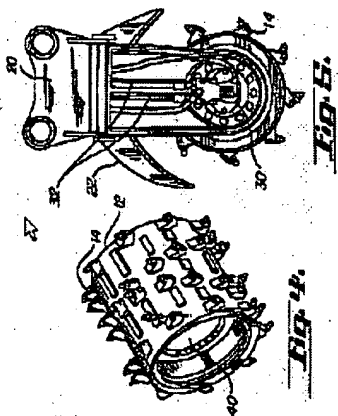
wear member because they appear to be inclined. The examiner notes that applicant has not claimed that the bearing faces are parallel to a longitudinal axis of said wear member, but instead has claimed that the bearing faces are substantially parallel to a longitudinal axis of said wear member. It is the examiner's position that the front and rear bearing faces of Robinson et al., are substantially parallel to a longitudinal axis of said wear member.

### ***Response Restriction to Arguments***

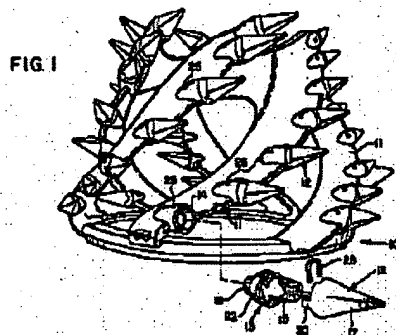
Applicant's election with traverse of the restriction mailed on 1/23/06 in the reply filed on 2/15/06 is acknowledged.

Regarding the restriction requirement between inventions I and II, applicant argues that the subcombinations are not distinct from each other. The examiner disagrees and notes that an excavator tooth system can indeed be used in a grinding tool (see LaBounty (6,438,874), and Hahn (4,470,210) as examples).

U.S. Patent Aug. 27, 2002 Sheet 3 of 10 US 6,438,874 B1



U.S. Patent Sep. 11, 1994 Sheet 1 of 2 4,470,210



Regarding the restriction requirement between inventions I and III, applicant argues that inventions I and III are not related as combination and subcombination. The examiner notes that the restriction requirement sets forth that inventions I and III are related and subcombinations disclosed as usable together in a single combination.

Regarding the restriction requirement between inventions I and IV applicant argues that the mounting of a wear member to a nose without partially misaligning the wear member with the lock aperture, does not materially differ from the claimed process, and that removing this small component does not materially change the process. It appears that applicant is suggesting that the examiner does not have to address this limitation in the examination or that it is not actually a limitation or part of the claim. This argument is not persuasive. Additionally, applicant's argument that no significant amount of additional searching will be required, is applicant's opinion which the examiner does not agree with. Furthermore, the examiner notes that as set forth under 37 CFR 1.141, "two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in

Art Unit: 3671

one national application, provided the application also includes an allowable claim gen-eric to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim”.

The requirement is still deemed proper and is therefore made FINAL.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Batson whose telephone number is (571) 272-6987. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will can be reached on (571) 272-6998. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3671

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 27, 2006



Victor Batson  
Primary Examiner  
Art Unit 3671